

App. Serial No. 10/517,538
Docket No.: FR020701US

Remarks

The Final Office Action dated November 30, 2007, notes the following rejections: claims 1-4 stand rejected under 35 U.S.C. § 103(a) over Vilppula (U.S. Patent Pub. 2002/0019698) in view of Roel-Ng (U.S. Patent No. 6,002,936) and further in view of Orlor (U.S. Patent No. 7,076,256); claims 6-9 stand rejected under 35 U.S.C. § 103(a) over the '698, '936, and '256 references and further in view of Ludwig (U.S. Patent No. 6,256,498); claims 10-11, 13 and 15-17 stand rejected under 35 U.S.C. § 103(a) over the '698 reference in view of the '256 reference; claims 18-20 stand rejected under 35 U.S.C. § 103(a) over the '698 and '256 references in view of Yabe (U.S. Patent Pub. 2003/0013458); and claim 21 stands rejected under 35 U.S.C. § 103(a) over the '698, '936 and '256 references in view of the '458 reference. Claim 10 is objected to due to informalities. In this discussion set forth below, Applicant does not acquiesce to any rejection or averment in this Office Action unless Applicant expressly indicates otherwise.

Applicant has corrected the typographical error in claim 10 that was noted in the Office Action. Applicant requests that the objection be removed.

Applicant respectfully traverses the § 103(a) rejection of claims 1-4, 6-11, 13, and 15-21 for reasons presented below. Applicant submits that the amendments to the claims also render the objections improper.

For instance, independent claim 1 includes limitations directed towards dynamic updating for new position devices and to ordering the position devices in response to a change in context. Applicant's specification teaches that this can be particularly useful because context changes and newly added devices, unlike position information requests, happen relatively infrequently. *See, e.g.*, Applicant's specification, Pg. 14:4-7. The primary '698 reference, however, uses an algorithm that cycles through each of the devices every time a position request is initiated. *See, e.g.*, '698 reference, FIG. 4. Accordingly, there is no correspondence to such aspects in the alleged combination.

With regards to independent claim 10, Applicant notes that the Office Action has apparently interpreted the claim limitations as requiring one type of the context information (*i.e.*, indoors). Applicant disagrees with this interpretation, but has amended the claims to expressly require context information about each of indoors, on foot and in

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transit. The Office Action has only attempted to show correspondence to a determination related to whether a GPS signal is detected (inferring that a device might be indoors). Accordingly, there is no correspondence to each of these aspects in the alleged combination.

Applicant also notes amendments and new dependent claims 22-24, which are also distinguishable over the cited combinations.

Applicant respectfully traverses the rejections that rely upon the combination of the '698 reference with that of the '936 reference because the combination is illogical. The two references teach two very different applications, and thus, the aspects taken from the '936 reference do not make sense in the context of the '698 reference. The '698 reference is directed towards a single locator device that can have multiple positioning mechanisms. The '936 reference is directed toward a cellular communication system in which a base-station controllers need to acquire positions of the cellular phones in the various cells. Applicant submits that simply equating functionality associated with a base station within a cellular system (the '936 reference) with that of a small locator device (the '698 reference) ignores the context of the references. Thus, while a base-station controller may be taught to activate a cellular phone, Applicant submits that the skilled artisan would not look to these disparate teachings and would not apply base-station controller functions to those of a single locator device of the '698 reference.

The substance of the Office Action's description for these two very different applications shows that the Office Action is focused on the individual functionality of each reference. The Supreme Court has explained that inventions are almost always, if not always, made from a combination of elements that are known. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 419 (U.S. 2007). It logically follows that it will always be possible to find the elements of a claim by breaking down the elements individually. Accordingly, it is exceedingly important to consider the totality of a claimed invention including an explanation of how the references would function together. *See also*, M.P.E.P. § 2141.02. In pertinent part, the Office Action describes two distinct applications for determining position information that operate entirely independent of one another, but fails to explain how these distinct and independent applications would function together and also correspond to the claim limitations. For instance, the first part

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of the Office Action describes functions carried out on an individual device (the '698 reference), whereas other portions of the Office Action describe functions carried out by a base controller (the '936 reference). Thus, the Office Action appears to have impermissibly broken the claim limitations into individual elements without addressing the claims as a whole.

The Office Action further complicates the allegations of correspondence by citing to functions carried out by a www server as taught by the '649 reference. This alleged combination plucks elements taught to be implemented by a single device (the '698 reference), a base station controller (the '936 device) and a www server (the '649 device). These differences are not accounted for in the Office Action, which merely concludes that the cell Ids would be used to obtain location-related information. Since the '698 device already has location-related information, and is not a www server, it is unclear why the skilled artisan would implement this odd combination of different elements. Moreover, it is unclear from the Office Action and the references how this combination functions. For instance, there is no consideration of where the cell Ids would be sent when the '698 reference does not have a www server.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, David Cordeiro, of NXP Corporation at (408) 474-9063 (or the undersigned).

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